

**Amendment and Response**

Applicant: Andrew W. Barr et al.

Serial No.: 10/714,386

Filed: Nov. 14, 2003

Docket No.: 200308581-1/H300.217.101

Title: SYSTEM AND METHOD FOR TESTING A MEMORY WITH AN EXPANSION CARD USING DMA

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**REMARKS**

The following remarks are made in response to the Office Action mailed March 5, 2007. Claims 9-14 were rejected. Claims 1-8 and 15-20 have been allowed. Claims 9 and 10 have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

**Examiner Interview Summary Pursuant to 37 CFR §1.133(b)**

Applicants appreciate the interview with Examiner Aditya Bhat on May 11, 2007. In the interview, Applicants discussed the rejection of claims 9-14 under 35 U.S.C. § 101 with the Examiner.

No agreement was reached between Applicant and the Examiner on any issues regarding the outstanding claims.

**Claim Rejections under 35 U.S.C. § 101**

Claims 9-14 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The Office Action has failed to set forth a *prima facie* case that claims 9-14 are directed to non-statutory subject matter. The Office Action does not allege that claims 9-14 are not within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. §101 (i.e., a process, a machine, a manufacture or a composition of material). See MPEP § 2106 (IV)(B). In addition, the Office Action does not identify a judicial exception to 35 U.S.C. §101 (e.g., abstract ideas such as mathematical algorithms, natural phenomena, or laws of nature) to which the Office Action believes claims 9-14 are directed. See MPEP § 2106 (IV)(C).

“The examiner bears the initial burden ... of presenting a prima facie case of unpatentability.” In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444, (Fed. Cir. 1992) (cited in MPEP § 2106 (IV)(D)). To establish a *prima facie* case that claims 9-14 are directed to non-statutory subject matter based on a judicial exception to 35 U.S.C. §101, the Office Action must identify and explain in the record the reasons why a claim is for an abstract idea with no practical application. See MPEP § 2106 (IV)(D). The

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present Office Action only alleges that claims 9-14 “are directed to a judicial exception”, Office Action, p. 2, and does not identify an abstract idea embodied by claims 9-14.

Even assuming *arguendo* that the Office Action can identify an abstract idea embodied by claims 9-14, the Office Action must show that claims 9-14 do not provide a transformation or reduction of an article to a different state or thing and do not produce a useful, tangible, and concrete result to demonstrate that claims 9-14 have no practical application. See MPEP §§ 2106 (IV)(C)(1) and 2106 (IV)(C)(2).

Claim 9 recites “providing the test transaction to the portion using direct memory access (DMA) to cause information to be read from or stored into the portion . . . .” Applicants respectfully submit that these features of claim 9 clearly transform “the portion” into a different state by causing “information to be read from or stored into the portion” and therefore claim 9 has a practical application. Accordingly, claim 9 and claims 10-14 which depend from claim 9 have a practical application and do not fall within a judicial exception to 35 U.S.C. §101 for at least this reason.

In addition, these features of claim 9 produce a useful, tangible, and concrete result. Namely, “providing the test transaction to the portion using direct memory access (DMA) to cause information to be read from or stored into the portion” produces a useful, tangible, and concrete result associated with “the portion”. Accordingly, claim 9 and claims 10-14 which depend from claim 9 have a practical application and do not fall within a judicial exception to 35 U.S.C. §101 for at least this additional reason.

Further, claim 10 has been amended to recite “performing a remedial action associated with the portion in response to detecting the error.” Applicants respectfully submit that this feature of claim 10 both provides a state transformation and produces a useful, tangible, and concrete result by “performing a remedial action”. Accordingly, claim 10 does not fall within a judicial exception to 35 U.S.C. §101 for at least this additional reason.

As described above, the Office Action has failed to set forth a *prima facie* case that claims 9-14 are directed to non-statutory subject matter. Accordingly, Applicants respectfully request withdrawal of rejection of claims 9-14 under 35 U.S.C. §101.

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**Allowable Claims**

Claims 1-8 and 16-20 are allowed.

Applicants appreciate the Examiner's consideration and allowance of these claims.

**CONCLUSION**

In view of the above, Applicants respectfully submit that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

The Examiner is invited to contact the Applicants' representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either David A. Plettner at Telephone No. (408) 447-3013, Facsimile No. (408) 447-0854 or Christopher P. Kosh at Telephone No. (512) 231-0533, Facsimile No. (512) 231-0540. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

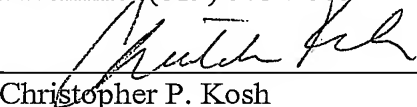
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